

PATENT

Atty Docket No.: 100110474-2
App. Ser. No.: 09/995,318

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the claim amendments and following remarks. Claims 1-3, 9-11 and 17-18 are pending in the present application of which claims 1-3, 9-11 and 17-18 are independent. Claim 1 has been amended to correct a typographical error. Claims 4-8, 12-16 and 19 have been cancelled. No new matter has been added.

Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,335,169 to Chong ("Chong") in view of U.S. Patent No. 6,298,333 to Manzi et al. ("Manzi et al."). These rejections are respectfully traversed for at least the following reasons.

Election/Restriction

The Office Action acknowledged Applicants' election without traverse of Invention 1 (claims 1-3) and Species V (claims 1-3, 9-11 and 17-18). The Office Action also stated that

The applicant has acknowledged that claims 4-8, 12-16, and 19 are withdrawn from consideration. *While this is true, the Examiner emphasizes that all of claims 4-19 are withdrawn from consideration as being drawn to non-elected inventions II-IV.*

As indicated in Applicants' response mailed July 30, 2004, claims 4-8, 12-16, and 19 are withdrawn from consideration without prejudice or disclaimer. In addition, Applicants respectfully note the provision in MPEP section 809.02(c), which states that:

An examiner's action subsequent to an election of species should include a complete action on the merits of all claims readable on the elected species.

Because the Office Action acknowledged Applicants' election of Invention 1 (claims 1-3) and Species V (claims 1-3, 9-11 and 17-18) (Office Action, page 2), Applicants respectfully request that it was improper for the Examiner to withdraw from consideration

PATENT

Atty Docket No.: 100110474-2

App. Ser. No.: 09/995,318

claims 9-11 and 17-18, in particular because claims 9-11 and 17-18 are readable on the elected species. To comply with the guidelines set forth above in MPEP section 809.02(c), Applicants respectfully note that a complete action on the merits should include an examination of all claims readable on the elected species, i.e. claims 1-3, 9-11 and 17-18. In addition, because claims 9-11 and 17-18 were improperly withdrawn from consideration (Office Action, page 2), and because claims 9-11 and 17-18 were not examined in the Office Action mailed March 8, 2005, the next Office Action on the merits with regard to all claims readable on the elected species, i.e. claims 1-3, 9-11 and 17-18, cannot be made final. Furthermore, MPEP section 809.02(e) states that

Whenever a generic claim is found to be allowable in substance, even though it is objected to or rejected on merely formal grounds, action on the species claims shall thereupon be given as if the generic claim were allowed.

Thus, if any of generic claims 1-3 is found to be allowable, claims 9-11 and 17-18 should be allowable because claims 9-11 and 17-18 belong to the elected species.

Drawings

At the outset, the indication that the drawings filed on June 24, 2002 are accepted is noted with appreciation.

Claim Objections

Claim 1 stands objected to because of an informality pertaining to a typographical error. The Office Action states that in claim 1, line 5, it appears "jurisidctions" should be -- jurisdictions--. Appropriate correction of claim 1 has been made.

PATENT

Atty Docket No.: 100110474-2

App. Scr. No.: 09/995,318

Claim Rejection Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

The Office Action sets forth a rejection of claims 1-3 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Chong in view of Manzi et al. This rejection is respectfully traversed.

Independent claim 1 recites "a first database having a directory of parameters identifying all domestic taxing jurisdictions by zip code requiring payment of taxes," "a second database having a directory of parameters identifying the taxability of goods and/or services by each jurisdiction identified by zip code in the first database, through the use of commodity codes," "a third database having a directory of parameters identifying all domestic sales, use and rental tax rates for each zip code" and "a server having programming for determining all taxes due on each transaction request input to the apparatus according to the directory parameters maintained by the first, second and third databases."

PATENT

Atty Docket No.: 100110474-2
App. Scr. No.: 09/995,318

Independent claim 2 recites "a first database having a directory of parameters identifying all domestic taxing jurisdictions by geocode requiring payment of taxes," "a second database having a directory of parameters identifying the taxability of goods and/or services by each jurisdiction identified by geocode in the first database, through the use of commodity codes," "a third database having a directory of parameters identifying all domestic sales, use and rental tax rates for each geocode," and "a server having programming for determining all taxes due on each transaction request input to the apparatus according to the directory parameters maintained by the first, second and third databases."

Independent claim 3 recites "a first database having a directory of parameters identifying all domestic taxing jurisdictions by jurisdiction name requiring payment of taxes," "a second database having a directory of parameters identifying the taxability of goods and/or services by each jurisdiction identified by jurisdiction name in the first database, through the use of commodity codes," "a third database having a directory of parameters identifying all domestic sales, use and rental tax rates for each jurisdiction name" and "a server having programming for determining all taxes due on each transaction request input to the apparatus according to the directory parameters maintained by the first, second and third databases."

Neither Chong nor Manzi et al. teach or suggest the features of independent claims 1-3.

Chong discloses a computerized system for tracking multiple types of sales tax assessments for different taxing authorities on different types of sales transactions with customers (Abstract).

Chong, however, fails to teach or suggest "a first database having a directory of parameters identifying all domestic taxing jurisdictions by zip code" as recited in independent claim 1, "a first database having a directory of parameters identifying all domestic taxing

PATENT

Atty Docket No.: 100110474-2
App. Ser. No.: 09/995,318

jurisdictions by geocode requiring payment of taxes" as recited in independent claim 2, or "a first database having a directory of parameters identifying all domestic taxing jurisdictions by jurisdiction name requiring payment of taxes" as recited in independent claim 3. Instead, Chong discloses assignment of a tax authority code for a tax authority. A tax authority code is neither a zip code, a geocode, nor a jurisdiction name. The tax authority code disclosed by Chong is used for tax reporting (Column 4, lines 25-30), instead of "identifying all domestic taxing jurisdictions by zip code" as recited in independent claim 1.

The Office Action acknowledges Chong's failure to teach or suggest "identifying all domestic taxing jurisdictions by zip code" as recited in independent claim 1 (Office Action, page 3). The Office Action states on page 3, "Chong lack specifically the use of a first second and third "database; the directory of jurisdictions being specifically by zip code; and the identity of use and rental tax rates." The Office Action never states Manzi (which was combined with Chong) or any other reference teaches identifying all domestic taxing jurisdictions by zip code and in fact Manzi fails to teach or suggest this feature.

The Office Action is silent with regard to "identifying all domestic taxing jurisdictions by geocode requiring payment of taxes" as recited in independent claim 2, and "identifying all domestic taxing jurisdictions by jurisdiction name requiring payment of taxes" as recited in independent claim 3. Applicants submit that it is improper to reject independent claims 2 and 3 in view of Chong, given that the Office Action has not addressed, and is completely silent with regard to, these features of independent claims 2 and 3.

In addition, Chong fails to teach or suggest identifying the taxability of goods and/or services "through the use of commodity codes" as recited in each of independent claims 1, 2 and 3. Instead, Chong discloses

PATENT

Atty Docket No.: 100110474-2
App. Ser. No.: 09/995,318

"The tax type maintenance module 34 is used to assign a tax type code to each one of a plurality of tax types, for example, taxable, non-taxable, and tax-exempt types." (Column 4, lines 34-37).

The assignment of a tax type code disclosed by Chong does not constitute "the use of commodity codes" as recited in each of independent claims 1, 2 and 3. Commodity codes identify commodities, not tax types. The Office Action alleges that Chong discloses

"a second module 34 having a directory identifying the taxability of goods by each jurisdiction through the use of codes" (Office Action, page 3)

However, the Office Action is silent with regard commodity codes and, in particular, identifying the taxability of goods and/or services "through the use of commodity codes" as recited in each of independent claims 1, 2 and 3. It is clear that Chong fails to teach or suggest the claimed "commodity codes" because "a tax type code" pertains not to commodities, but instead pertains to tax types (see Chong, Column 4, lines 34-37).

Chong also fails to teach or suggest "a server having programming for determining all taxes due on each transaction request input to the apparatus according to the directory parameters maintained by the first, second and third databases" as recited in each of independent claims 1, 2 and 3. Instead, Chong discloses a system for tracking sales tax assessments, including a support file maintenance interface for maintaining support files for different tax types, a sales entry interface for entering sales orders, a sales recording module for creating a sales record, and a sales tax reporting module for sorting sales records. (Column 2, lines 50-68 through Column 3, lines 1-26). The system for tracking sales tax assessments disclosed by Chong is used for tracking purposes. The tracking system of Chong is used for tracking sales tax assessments, and Chong fails to teach or suggest that the tracking system provides programming capabilities "for determining all taxes due on each

PATENT

Atty Docket No.: 100110474-2
App. Ser. No.: 09/995,318

transaction request" as claimed. Thus, for at least these reasons, Chong fails to teach or suggest all the features of independent claims 1-3.

Manzi et al. fails to remedy the deficiencies of Chong. Manzi et al. discloses a system and method for a lessor to determine use tax on moveable equipment which may be subject to tax by more than one tax authority (Abstract).

Manzi et al., however, fails to teach or suggest "a first database having a directory of parameters identifying all domestic taxing jurisdictions by zip code" as recited in independent claim 1, "a first database having a directory of parameters identifying all domestic taxing jurisdictions by geocode requiring payment of taxes" as recited in independent claim 2, or "a first database having a directory of parameters identifying all domestic taxing jurisdictions by jurisdiction name requiring payment of taxes" as recited in independent claim 3. Instead, the system of Manzi et al. uses inventory records for individual items (Abstract). The inventory records disclosed by Manzi et al. include equipment identifier and equipment category. Nowhere does Manzi et al. teach or suggest the use of zip code, geocode, or jurisdiction name for identifying equipment or for use in inventory records. Moreover, Manzi et al. fails to teach or suggest "identifying the taxability of goods and/or services" "through the use of commodity codes" as recited in independent claims 1, 2 and 3. The use tax on moveable equipment, as disclosed by Manzi et al., is based on inventory records rather than commodity codes. Furthermore, Manzi et al. fails to teach or suggest identifying the taxability of goods and/or services" as recited in independent claims 1, 2 and 3. Instead, the use tax disclosed by Manzi et al. pertains solely to moveable equipment (Column 1, lines 50-55).

PATENT

Atty Docket No.: 100110474-2

App. Ser. No.: 09/995,318

Thus, for at least these reasons, Manzi et al. also fails to teach or suggest all the features of independent claims 1, 2 and 3. Since Manzi et al. fails to remedy the deficiencies of Chong, the Applicants respectfully request withdrawal of the rejection.

For at least the reasons discussed above, the Applicants respectfully submit that neither Chong nor Manzi et al., whether alone or in combination, teach or suggest the subject matter of independent claims 1-3.

Conclusion


In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited. Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Robert J. Gallagher

Dated: June 6, 2005

By



Ashok K. Mannava
Registration No. 45,301

MANNAVA & KANG, P.C.
8221 Old Courthouse Road
Suite 104
Vienna, VA 22182
(703) 652-3822
(703) 880-5270 (facsimile)